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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,789	03/31/2004	Thamer A. Abanami	MSI-1935US	9919
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LEE & HAYES, PLLC 601 W. RIVERSIDE AVENUE SUITE 1400 SPokane, WA 99201			AHN, SANGWOO	
ART UNIT	PAPER NUMBER		2168	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/816,789	ABANAMI ET AL.
	<b>Examiner</b> SANGWOO AHN	<b>Art Unit</b> 2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 02 December 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1 – 2, 4, 6 – 27 and 29 – 36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 – 2, 4, 6 – 27 and 29 – 36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/2/2009 has been entered.

***Response to Amendment***

Claims 1 – 2, 4, 6 – 27 and 29 – 36 are pending.

The Declaration filed on 12/2/2008 under 37 CFR 1.131 is sufficient to overcome the Hurwitz (U.S. Patent Publication Number 2005/0147130) reference.

A new ground(s) of rejection is made in view of different interpretation of previously applied reference (Robbin) and a newly found prior art reference (Aravamudan).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 31 – 36 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.

For a system or an apparatus to be hardware, at least one of the recited elements must be hardware. If every element can be reasonably interpreted as software in light of the specification, the claim is directed to software *per se*, therefore non-statutory. In general, inclusion of a computer processor and a computer readable storage medium in the claim would constitute hardware.

Claims 32 – 36 are rejected due to dependency.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 2, 4, 6 – 27 and 29 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication Number 2003/0167318 issued to Jeffrey L. Robbin et al. (hereinafter “Robbin”) in view of U.S. Patent Number 6,301,609 issued to Murali Aravamudan et al. (hereinafter “Aravamudan”).**

Regarding claim 1, Robbin discloses,

One or more processor-readable media having processor-executable instructions that, when executed by a processor, performs acts comprising:

determining a storage capacity of a target device coupled to a source device (paragraph 46 lines 1 – 3: determine whether media device has the capacity to store media items);

sorting a collection of digital items stored on the source device and dividing the collection into multiple tiers of digital items (paragraph 46 lines 20 – 22: identify media items on the host computer that are not on the media device → items that are already stored on the media device and items that are not stored on the media device are sorted separately, and each category of items (stored vs. not stored) can be interpreted as a tier of items, et seq.) wherein each tier is a subset of the collection (each tier contains a number of digital items) and the items in each tier have like priorities (items in "stored" tier would not be transferred and items in "not stored" tier would be transferred) and the priority of items in one tier differs from the priority items in the other tiers (items in "stored" tier are different from items in "not stored" tier);

designating at least one of the tiers of sorted digital items with highest priority for synchronization with the target device (items in "not stored" tier would have the highest priority to be transferred to the media device, whereas items in "stored" tier would have a lower or no priority), wherein the storage requirements of the designated tier of digital items are less than or equal to the storage capacity of the target device (paragraph 47, et seq.);

synchronizing the designated tier of digital items with the coupled target device (paragraph 48, et seq.).

Robbin does not explicitly disclose "sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection."

However, Aravamudan discloses sorting based upon a user-configurable priority assigned to the digital items in the collection (column 2 lines 33 – 40: user defines specific attributes to associates included in each group ... included within each associate definition is a user-selected priority assignment ... allows selection of one of three priority assignments: low, high, and highest.). At the time the invention was made, it would have been obvious to a person of ordinary skill in the data processing art to modify Robbin's data synchronization system to incorporate Aravamudan's method of assigning priorities to digital items, thus providing a user with an option to designate priorities to digital items, realizing the user's preference in data synchronization setting.

Regarding claim 2, Aravamudan discloses,  
providing a user-interface which facilitates user-configurable assignment of priority for one or more digital items in the collection (column 2 lines 33 – 40, column 12 lines 49 – 53, et seq.).

Regarding claim 4, Robbin discloses,  
the storage requirements of the collection of digital items is greater than the defined storage capacity of the target device ((paragraph 55 lines 6 - 9: when the decision determines that the media device does not have sufficient capacity, then the number of media items to be stored is limited, et seq.).

Regarding claim 6, Robbin discloses,

the synchronizing further comprises directing the target device to remove a digital item stored thereon but not part of the designated tier of digital items for synchronization (synchronization in computing essentially means "the process of making sure that two or more locations contain the same up-to-date files ... If you add, change, or delete a file from one location, the synchronization process will add, change, or delete the same file at the other location." Wikipedia, [http://en.wikipedia.org/wiki/File\\_synchronization](http://en.wikipedia.org/wiki/File_synchronization)).

Regarding claim 7, Robbin discloses,

the synchronizing further comprises transferring from the source device a digital item which is part of the designated tier of digital items for synchronization but not already stored on the target device (synchronization in computing essentially means "the process of making sure that two or more locations contain the same up-to-date files ... If you add, change, or delete a file from one location, the synchronization process will add, change, or delete the same file at the other location." Wikipedia, [http://en.wikipedia.org/wiki/File\\_synchronization](http://en.wikipedia.org/wiki/File_synchronization)).

Regarding claim 8, Robbin discloses,

digital items are audio, image, or video files (paragraph 5, et seq.).

Regarding claim 9, Robbin discloses,

digital items are selected from a group of digital content consisting of audio, image, video, text, hypertext, and data (paragraph 5, et seq.).

Claims 10 – 11 are rejected based on the same rationale discussed in claim 1 rejection and Figures 1 and 2, et seq.

Regarding claim 12, Robbin discloses,

One or more processor-readable media having processor-executable instructions that, when executed by a processor, produce a user-interface (UI), the UI comprising:

a first display area illustrating a listing of one or more digital items from a collection of digital items stored on a source device, the collection being divided into multiple tiers (paragraph 29, (paragraph 46 lines 20 – 22: identify media items on the host computer that are not on the media device → items that are already stored on the media device and items that are not stored on the media device are sorted separately, and each category of items (stored vs. not stored) can be interpreted as a tier of items, et seq., et seq.), wherein each tier is a subset of the collection and the items in each tier have like properties for synchronization with a target device coupled to the source device (items in "stored" tier would not be transferred and items in "not stored" tier would be transferred) and one of the tiers having the highest priority amongst the multiple tiers (items in "not stored" tier would have the highest priority to be transferred to the media device, whereas items in "stored" tier would have a lower or no priority);

an executable process associated with the one or more digital items in the listing that is configured to:

    determine a storage capacity of the target device (paragraph 55 lines 1 – 4: determines whether the media device has the capacity to store all the identified media items, determined whether the media device has sufficient storage capacity, et seq.);

designate the tier with highest priority (items in "not stored" tier would have the highest priority to be transferred to the media device, whereas items in "stored" tier would have a lower or no priority) wherein the storage requirements of the designated tier of digital items are less than or equal to the storage capacity of the target device (paragraph 47, et seq.); synchronize the designated tier of digital items with the coupled target device (paragraph 48, et seq.).

Robbin does not explicitly disclose "a display area illustrating a user-configurable priority corresponding to the one or more digital items."

However, Aravamudan discloses a display area illustrating a user-configurable priority corresponding to the one or more digital items (column 2 lines 33 – 40: user defines specific attributes to associates included in each group ... included within each associate definition is a user-selected priority assignment ... allows selection of one of three priority assignments: low, high, and highest.). At the time the invention was made, it would have been obvious to a person of ordinary skill in the data processing art to modify Robbin's data synchronization system to incorporate Aravamudan's method of assigning priorities to digital items, thus providing a user with an option to designate priorities to digital items, realizing the user's preference in data synchronization setting.

Regarding claim 13, Robbins discloses, the storage requirements of the collection of digital items is greater than the defined storage capacity of the target device (paragraph 55 lines 6 - 9: when the

decision determines that the media device does not have sufficient capacity, then the number of media items to be stored is limited, et seq.).

Regarding claim 14, Aravamudan discloses,  
the user-configurable priority assigned to a digital item is indicated as one of multiple priority tiers (column 2 lines 33 – 40, et seq.).

Regarding claim 15, Robbin discloses,  
the synchronizing further comprises directing the target device to remove a digital item stored thereon but not part of the designated tier of digital items for synchronization (synchronization in computing essentially means "the process of making sure that two or more locations contain the same up-to-date files ... If you add, change, or delete a file from one location, the synchronization process will add, change, or delete the same file at the other location." Wikipedia, [http://en.wikipedia.org/wiki/File\\_synchronization](http://en.wikipedia.org/wiki/File_synchronization)).

Regarding claim 16, Robbin discloses,  
the synchronizing further comprises transferring from the source device a digital item which is part of the designated tier of digital items for synchronization but not already stored on the target device (synchronization in computing essentially means "the process of making sure that two or more locations contain the same up-to-date files ... If you add, change, or delete a file from one location, the synchronization process will add, change, or delete the same file at the other location." Wikipedia, [http://en.wikipedia.org/wiki/File\\_synchronization](http://en.wikipedia.org/wiki/File_synchronization)).

Regarding claim 17, Robbin discloses,  
digital items are audio, image, or video files (paragraph 5, et seq.).

Regarding claim 18, Robbin discloses,

digital items are selected from a group of digital content consisting of audio, image, video, text, hypertext, and data (paragraph 5, et seq.).

Regarding claim 19, Robbin discloses,

A method comprising:

determining a storage capacity of a target device (paragraph 46 lines 1 – 3: determine whether media device has the capacity to store media items);  
sorting a collection of digital items into multiple groups of digital items (paragraph 46 lines 20 – 22: identify media items on the host computer that are not on the media device → items that are already stored on the media device and items that are not stored on the media device are sorted separately, and each category of items (stored vs. not stored) can be interpreted as a tier of items, et seq.) wherein the items in each group have like priorities (items in "stored" tier would not be transferred and items in "not stored" tier would be transferred) and the priority of items in one group differs from the priority of items in the other groups (items in "stored" tier are different from items in "not stored" tier);

designating at least one of the groups of sorted digital items with highest priority for synchronization with the target device (items in "not stored" tier would have the highest priority to be transferred to the media device, whereas items in "stored" tier would have a lower or no priority), wherein the storage requirements of the designated

group of digital items are less than or equal to the storage capacity of the target device (paragraph 47, et seq.);

synchronizing the designated tier of digital items with the coupled target device (paragraph 48, et seq.).

Robbin does not explicitly disclose “sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection.”

However, Aravamudan discloses sorting based upon a user-configurable priority assigned to the digital items in the collection (column 2 lines 33 – 40: user defines specific attributes to associates included in each group ... included within each associate definition is a user-selected priority assignment ... allows selection of one of three priority assignments: low, high, and highest.). At the time the invention was made, it would have been obvious to a person of ordinary skill in the data processing art to modify Robbin’s data synchronization system to incorporate Aravamudan’s method of assigning priorities to digital items, thus providing a user with an option to designate priorities to digital items, realizing the user’s preference in data synchronization setting.

Regarding claim 20, Robbin discloses,  
providing a user-interface which facilitates user-configurable assignment of priority for one or more digital items in the collection (paragraph 29, et seq.).

Regarding claim 21, Robbin discloses,  
the storage requirements of the collection of digital items is greater than the defined storage capacity of the target device (paragraph 55 lines 6 - 9: when the

decision determines that the media device does not have sufficient capacity, then the number of media items to be stored is limited, et seq.).

Regarding claim 22, Aravamudan discloses,  
the user-configurable priority assigned to a digital item is indicated as one of multiple priority tiers (column 2 lines 33 – 40, et seq.).

Regarding claim 23, Robbin discloses,  
the synchronizing further comprises directing the target device to remove a digital item stored thereon but not part of the designated group of digital items for synchronization (synchronization in computing essentially means "the process of making sure that two or more locations contain the same up-to-date files ... If you add, change, or delete a file from one location, the synchronization process will add, change, or delete the same file at the other location." Wikipedia,  
[http://en.wikipedia.org/wiki/File\\_synchronization](http://en.wikipedia.org/wiki/File_synchronization)).

Regarding claim 24, Robbin discloses,  
the synchronizing further comprises transferring from the source device a digital item which is part of the designated group of digital items for synchronization but not already stored on the target device (synchronization in computing essentially means "the process of making sure that two or more locations contain the same up-to-date files ... If you add, change, or delete a file from one location, the synchronization process will add, change, or delete the same file at the other location." Wikipedia,  
[http://en.wikipedia.org/wiki/File\\_synchronization](http://en.wikipedia.org/wiki/File_synchronization)).

Regarding claim 25, Robbin discloses,

digital items are audio, image, or video files (paragraph 5, et seq.).

Regarding claim 26, Robbin discloses,

digital items are selected from a group of digital content consisting of audio, image, video, text, hypertext, and data (paragraph 5, et seq.).

Regarding claim 27, Robbin discloses,

One or more processor-readable media having processor-executable instructions that, when executed by a processor, produce a user-interface (UI), the UI comprising:

a first display area illustrating a listing of one or more digital items from a collection of digital items stored on a source device, the collection being divided into multiple tiers (paragraph 29, (paragraph 46 lines 20 – 22: identify media items on the host computer that are not on the media device → items that are already stored on the media device and items that are not stored on the media device are sorted separately, and each category of items (stored vs. not stored) can be interpreted as a tier of items, et seq., et seq.), wherein each tier is a subset of the collection and the items in each tier have like properties for synchronization with a target device coupled to the source device (items in "stored" tier would not be transferred and items in "not stored" tier would be transferred) and one of the tiers having the highest priority amongst the multiple tiers (items in "not stored" tier would have the highest priority to be transferred to the media device, whereas items in "stored" tier would have a lower or no priority);

Robbin does not explicitly disclose "a display area illustrating a user-configurable priority corresponding to the one or more digital items."

However, Aravamudan discloses a display area illustrating a user-configurable priority corresponding to the one or more digital items (column 2 lines 33 – 40: user defines specific attributes to associates included in each group ... included within each associate definition is a user-selected priority assignment ... allows selection of one of three priority assignments: low, high, and highest.). At the time the invention was made, it would have been obvious to a person of ordinary skill in the data processing art to modify Robbin's data synchronization system to incorporate Aravamudan's method of assigning priorities to digital items, thus providing a user with an option to designate priorities to digital items, realizing the user's preference in data synchronization setting.

Regarding claim 25, Robbin discloses,

digital items are audio, image, or video files (paragraph 5, et seq.).

Regarding claim 26, Robbin discloses,

digital items are selected from a group of digital content consisting of audio, image, video, text, hypertext, and data (paragraph 5, et seq.).

Regarding claim 31, Robbin discloses,

A system comprising:

a storage capacity determining means for determining a storage capacity of a target device coupled to a source device (paragraph 46 lines 1 – 3: determine whether media device has the capacity to store media items);

a sorting-and-dividing means for sorting a collection of digital items stored on the source device and dividing the collection into multiple groups of digital items (paragraph

46 lines 20 – 22: identify media items on the host computer that are not on the media device → items that are already stored on the media device and items that are not stored on the media device are sorted separately, and each category of items (stored vs. not stored) can be interpreted as a tier of items, et seq.), wherein the items in each group have like priorities (items in "stored" tier would not be transferred and items in "not stored" tier would be transferred) and the priority of items in one group differ from the priority of items in the other groups (items in "stored" tier are different from items in "not stored" tier);

a designating means for designating one of the groups of sorted digital items with highest priority for synchronization with the target device (items in "not stored" tier would have the highest priority to be transferred to the media device, whereas items in "stored" tier would have a lower or no priority), wherein the storage requirements of the designated group of digital items are less than or equal to the storage capacity of the target device (paragraph 47, et seq.);

a synchronizing means for directing the target device to remove a digital item stored thereon but not part of the designated group of digital items for synchronization and for transferring from the source device a digital item which is part of the designated group of digital items for synchronization but not already stored on the target device (synchronization in computing essentially means "the process of making sure that two or more locations contain the same up-to-date files ... If you add, change, or delete a file from one location, the synchronization process will add, change, or delete the same file at the other location." Wikipedia, [http://en.wikipedia.org/wiki/File\\_synchronization](http://en.wikipedia.org/wiki/File_synchronization)).

Robbin does not explicitly disclose "sorting being based, at least in part, upon a user-configurable priority assigned to the digital items in the collection."

However, Aravamudan discloses sorting based upon a user-configurable priority assigned to the digital items in the collection (column 2 lines 33 – 40: user defines specific attributes to associates included in each group ... included within each associate definition is a user-selected priority assignment ... allows selection of one of three priority assignments: low, high, and highest.). At the time the invention was made, it would have been obvious to a person of ordinary skill in the data processing art to modify Robbin's data synchronization system to incorporate Aravamudan's method of assigning priorities to digital items, thus providing a user with an option to designate priorities to digital items, realizing the user's preference in data synchronization setting.

Regarding claim 32, Robbin discloses,

providing a user-interface which facilitates user-configurable assignment of priority for one or more digital items in the collection (paragraph 29, et seq.).

Regarding claim 33, Robbin discloses,

the storage requirements of the collection of digital items is greater than the defined storage capacity of the target device (paragraph 55 lines 6 - 9: when the decision determines that the media device does not have sufficient capacity, then the number of media items to be stored is limited, et seq.).

Regarding claim 34, Aravamudan discloses,

the user-configurable priority assigned to a digital item is indicated as one of multiple priority tiers (column 2 lines 33 – 40, et seq.).

Regarding claim 35, Robbin discloses,

digital items are audio, image, or video files (paragraph 5, et seq.).

Regarding claim 36, Robbin discloses,

digital items are selected from a group of digital content consisting of audio, image, video, text, hypertext, and data (paragraph 5, et seq.).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SANGWOO AHN whose telephone number is (571)272-5626. The examiner can normally be reached on M-F 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/816,789  
Art Unit: 2168

Page 18

3/25/2009  
/S. A./  
Examiner, Art Unit 2168

/Tim T. Vo/  
Supervisory Patent Examiner, Art Unit 2168